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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,224	06/25/2003	Thomas S. Murphy	3317.126 US1	4383

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WILMER CUTLER PICKERING HALE AND DORR LLP
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BOSTON, MA 02109

EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

NOTIFICATION DATE	DELIVERY MODE
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09/06/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/603,224	Applicant(s) MURPHY ET AL.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments in response to the Office action dated 12/14/06 have been fully considered.

1. Claims 1-28 are cancelled. Claims 29-44 are new claims. Support for newly added claims is found in the specification.
2. Claim objection to claims 1-3 and 14 is moot because these claims are cancelled.
3. All of the double patenting rejections to claims 1-28 is moot, because these claims are cancelled. However, upon further consideration a new obviousness type double patenting rejection is made.
4. All of the previously made art rejections to claims 1-28 are moot because these claims are cancelled. However, upon further consideration a new 35 USC Section 102 (b) rejection is made based on the reference of Murphy et al. (US 5,762,623).
5. The declaration submitted by Mr. Michael C. Miller (Mr. Miller) is thoroughly reviewed, but it is not found persuasive. The declaration is deficient.

Claim Objections

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 37 should be renumbered as 35.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 30 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (US 5,762,623).

Murphy teaches a laminated tape/bandage comprising a layer of transversely spaced longitudinally extending elastic strands between a pair of outer layers, at least one of which is a warp-knitted (weft insertion) fabric oriented with the knit yarns extending longitudinally and generally parallel to the orientation of the elastic strands (abstract). Additionally, Murphy teaches that a binder (adhesive) is used to laminate all three layers and that the binder impregnates all three layers (column 3 lines 5-17). The Figure 1 of Murphy discloses the layer of elastic strands 16, which is porous and it is equated to the porous backing substrate. Additionally, the warp-knitted (weft insertion) fabric of Murphy as shown in Figure 3 and 4 is porous and it is impregnated or laminated with the adhesive binder, therefore it is equated to the adhesive-carrying fabric as claimed. Further, Murphy teaches that the preferred warp-knitted (weft insertion) fabric has a thread count of 18*16 (column 2 lines 40-52). Accordingly, Murphy anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29, 31-34, 37-43, and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Schueler (US 2,740,403) alone.

Schueler discloses adhesive bandages for medical and surgical purpose (column 1, line 15-16). The adhesive bandage of Schueler is a two-ply bandage containing a backing, which is made from a porous fabric and another thickness (known as carrier) made of an open mesh fabric that is impregnated or coated with an adhesive in such manner that the fabric remains substantially porous (column 1, lines 22-33). The carrier of Schueler is adhered to one surface of the backing to form two-ply bandage (column 1, line 33-34). The examiner is equating the carrier of Schueler as an adhesive-carrying fabric as claimed and the porous backing of Schueler as a porous backing substrate as claimed. Additionally, Schueler discloses that the carrier layer (adhesive-carrying fabric) can be formed in a great variety of manners. It may be woven, knitted or otherwise formed to give an open-mesh fabric which is subjected to an impregnation treatment with the adhesive and then after the impregnation can also be given an additional coating on its outer surface and in any case in the result, so that by differential pressure treatment, striking off, doctoring, or otherwise, it still presents,

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although impregnated, a substantially porous structure (column 1 lines 56-65). With respect to the porous backing, Schueler discloses that the porous backing is a closely woven fabric having say thread count of 100 yarns to the inch with openings between the yarns of 0.005 inch. Thus, although the woven fabric is closely woven, it is pervious (column 2 lines 42-47). Further the backing of Schuler is elastic (column 1 line 28).

The difference between the claimed invention and the prior art of Schueler is that Schueler is silent with respect to teaching the fabric after application of adhesive having greater than about 60% of open area, the fabric after application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the fabric prior to application of adhesive having in the range of about 50% to about 95% open area and after the application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the porous backing substrate has greater than about 50% of open area, and adhesive of the adhesive carrying fabric penetrates into about 25% to about 75% of the thickness of the porous backing. However, it is noted that Schueler discloses general condition of claims, specifically; Schueler discloses a two-ply bandage (article) having a porous backing substrate and a porous adhesive-carrying fabric that is applied to the backing substrate. Therefore, Schueler discloses general structure of Applicant's claimed article. Further the reference of Schueler and that of Applicant are in the same field of endeavor, namely in the field of breathable adhesive bandages. Additionally, throughout the Schueler reference, specifically at column 1 lines 30-35 and lines 55-65, column 2 lines

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3-15 and lines 42-47, Schueler discloses that both the porous backing and the fabric that is impregnated with the adhesive should remain porous. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the porosity of the fabric and the backing such that the fabric after application of adhesive having greater than about 60% of open area, the fabric after application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the fabric prior to application of adhesive having in the range of about 50% to about 95% open area and after the application of adhesive having an open area that is not more than about 10% to about 20% less than the open area of the fabric prior to the application of adhesive, the porous backing substrate has greater than about 50% of open area, and adhesive of the adhesive carrying fabric penetrates into about 25% to about 75% of the thickness of the porous backing, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

As to the claim limitation of the adhesive having sufficient internal cohesive strength such that the article is removable from a substrate without separation of the backing substrate and the adhesive carrying-fabric, it is noted that the structure of the product of Schueler and that of the Applicant is same. Specifically, the article of Schueler and that of Applicant comprises a porous substrate and an adhesive carrying fabric applied onto a porous substrate. Moreover, the end use of Applicant's article and that of Schueler is the same, namely in the field of adhesive bandages. Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adhesive bandage with an adhesive having sufficient internal cohesive strength such that it can be easily removed from skin without any pain or irritation.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schueler et al. (US 2,740,403) alone as applied to claim 33 above, further in view of Murphy et al. (US 5,762,623).

The invention of Schueler is previously disclosed. Schueler is silent with respect to teaching wherein the porous adhesive-carrying fabric has a thread count in at least one direction that is not more than 18 yarns per inch. However, Murphy teaches a laminated tape/bandage comprising a layer of transversely-spaced, longitudinally-extending elastic strands between a pair of outer layers, at least one of which is a warp-knitted (weft insertion) fabric oriented with knit yarns extending longitudinally and generally parallel to the orientation of the elastic strands (see abstract). Further Murphy teaches that the laminated tape/bandage is light, comfortable to wear, can be easily torn transversely by hand and when so torn tears cleanly substantially perpendicularly across the width of the tape/bandage (column 3, lines 19-25). Additionally Murphy discloses warp weft thread count of 18*16 (column 2, line 46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the warp-knitted (weft insertion) fabric of Murphy in the invention of Schueler as a carrier layer (adhesive-carrying fabric), motivated by the desire to create adhesive bandage that is light, comfortable to wear, and can be easily torn transversely by hand

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and when so torn tears cleanly substantially perpendicularly across the width of the adhesive bandage.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 29-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-8, 17, 28, 29, and 31 of copending Application No. 11/204,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 29-44 encompass the same subject matter as disclosed by claims 5-8, 17, 28, 29, and 31 of S/N 11/204,736.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed on 06/18/07 have been fully considered but they are not persuasive. The Examiner thanks Applicant for in depth analysis of Schueler reference.

Applicant has calculated the % open area (porosity) of the porous backing and the adhesive-carrying fabric of Schueler before the application of the adhesive to the fabric, which is 25% and 44% respectively. Applicant argues that based on the calculations, the porous backing substrate of Schueler cannot be more than 25% open and the adhesive carrying fabric of Schueler cannot be more than 44% open prior to impregnation. Additionally, Applicant asserts that the declaration provided by Mr. Miller shows that Schueler's carrier (adhesive carrying fabric) when impregnated with the adhesive loses nearly all of its porosity. The Examiner respectfully disagrees with Applicant for following reasons.

It is noted that the calculation of porosity of the porous backing of Schueler is based on the yarn openings (0.005 inch) and the thread count (100 yarns/inch) of the porous backing as disclosed by Schueler. While it is true that the narrower teaching of Schueler does not anticipate Applicant's invention, to the Examiner the overall teaching of Schueler does not preclude one of ordinary skill in the art from modifying his invention. Specifically, the reference of Schueler when considered as a whole, suggests that both the porous backing and the fabric of the adhesive-carrying fabric should remain open (see column 1 lines 32-33 and lines 47-55, column 2 lines 4-15, and column 3 lines 27-35). To the Examiner, Applicant is relying on a narrower

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teaching of Schueler and ignoring the broader teaching of Schueler. Schueler discloses general conditions of the presently claimed invention. Specifically, Schueler discloses a porous backing substrate and an adhesive-carrying fabric that is applied to the porous backing substrate as claimed. Additionally, as previously noted, Schueler discloses that both the porous backing substrate and the adhesive-carrying fabric should remain porous. Moreover, the invention of Schueler and that of the presently claimed invention have same utility (i.e. adhesive bandage). When general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233). It is noted that Applicant has calculated the porosity of the porous adhesive-carrying fabric of Schueler based on the assumption that the fabric of the adhesive-carrying fabric is same as that of the fabric of the porous backing substrate. Further, Applicant is relying on Figure 3 of Schueler to conclude that the diameter of the yarns of the adhesive-carrying fabric is similar to that of the diameter of the porous backing of Schueler. It is noted that Schueler does not teach that both fabrics (i.e. fabric of the backing and adhesive-carrying fabric) are same. Schueler discloses that the fabric of the adhesive-carrying fabric is similar to the fabric of the porous backing. The Examiner respectfully reminds Applicant that Applicant cannot rely upon drawings to calculate the diameter of the yarns, and hence the porosity of the adhesive-carrying fabric of Schueler. Additionally, even if assuming *arguendo* that Applicant is correct, the Examiner's rebuttal set forth above with respect to the porosity of the porous backing substrate applies.

As to the Applicant's arguments using the declaration of Mr. Miller as a basis, these arguments are not found persuasive, because the declaration is not found convincing. The declaration is found deficient for the following reasons:

(a) The declaration does not compare Applicant's invention to the closest prior art of Schueler. Mr. Miller states that he did not find a fabric with 67 yarns per inch in both warp and weft direction (see section 3 page 2 of the declaration) but he was able to obtain a woven cotton fabric having 75 yarns per inch in the warp direction and 44 yarns per inch in the weft direction. It is noted that the thread count of Schueler's fabric is 67 yarns per inch according to Applicant's calculations. Therefore, Applicant fails to compare the claimed invention with the closest prior art, which is one of the requirements for a proper declaration (see MPEP 716.02(e)).

(b) The declaration generally states that a water based pressure sensitive adhesive was used and that the materials were oven-dried and placed on a release paper. However, the declaration does not disclose as to what type of adhesive was used (i.e. composition) or what conditions are used to dry the samples. Further it is not clear as to whether a thicker adhesive or a thinner adhesive (i.e. viscosity) used to coat the samples.

(c) The details (e.g. yarn openings) in the photographs supplied with the declaration are not clearly visible.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Elizabeth M. Cole/
Primary Examiner,
Art Unit 1771

/A. D./
APD